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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/482,859	01/14/2000	Hideo Hagiwara	511.33114VV4	7601

20457 7590 12/16/2002

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EXAMINER

CHU, JOHN S Y

ART UNIT PAPER NUMBER

1752

DATE MAILED: 12/16/2002

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/482,859

Applicant(s)

NUNOMURA ET AL.

Examiner

John S. Chu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14, 21-25, 28-31 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14, 21-25, 28-31 and 34-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Office action is in response to the reconsideration and Terminal Disclaimer received October 17, 2002.

1. The rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 and 21 of U.S. Patent No. 5,856,059 is **withdrawn** in view of the Terminal Disclaimer received October 17, 2002.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 10,11,13,14,21-25,28-30,31 and 34-37 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by HAGIWARA ET AL.

The claimed invention is drawn to a photosensitive resin composition which comprises (1) a polyimide precursor formed from an oxydiphthalic acid or acid anhydride thereof with a diamine, (2) an addition-polymerizable compound, and (3) a photoinitiator, and which is adapted to be exposed and developed using an i-line stepper which uses monochromatic light.

HAGIWARA ET AL anticipates the claimed invention at Example 13 and Synthesis Example 19. The polyamic acid is a condensation product of an oxyphthalic acid and diamino

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diphenyl ether wherein the polyamic acid is in a composition with a tetraethylene glycol diacrylate and a photoinitiator of 4,6 dimethyl-7-ethylaminocourmarin.

The amendment to claim 25 reciting the transmittance of the composition at 365 nm for a 20 μ m thick film of at least 40% is noted and is asserted to be anticipated by the prior art composition of HAGIWARA ET AL '823 due to the presence of same or similar components in the composition. Objective evidence presented in the case measuring the transmittance under the same circumstances may serve to overcome this rejection.

The remarks by applicant have been noted which intend to establish that the portions of the U.S. Patent 5,472,823, Example 13 and Synthesis Example 19 relied upon in the rejection are subject matter "to another". Applicant's attorney reference portions of the MPEP 716.10 paragraph bridging the left- and right columns of page 700-229. This disclosure is noted, however the previous paragraph of page 700-229 state that "It is incumbent upon the inventors named in the application, ...to rebut a rejection under 35 U.S.S. 102(a) or (e) , to provide a satisfactory showing by way of affidavit under 37 CFR 1.132 (emphasis) that the inventorship of the application is correct in that the reference discloses subject matter derived from the applicant rather than invented by the author, patentee, or applicant of the published application notwithstanding the authorship of the article for the inventorship of the patent or published application. *In re Katz*, 687 F.2d 450, 455,215 USPQ 14,18, (CCPA 1982)...".

Because applicants have not provided an affidavit under 37 CFR 1.132 establishing that the disclosed subject matter in US. Patent 5,472,823, Example 13 and Synthesis Example 19 is derived from the applicant, the rejection is repeated and remains. The declaration in the

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application under 37 CFR 1.63 is not seen to be sufficient to overcome the prior art rejection over U.S. Patent 5,742,823.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

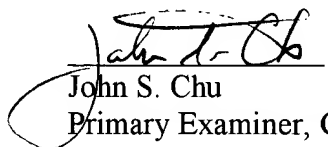
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on M-F from 9:30 am to 6:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John S. Chu
Primary Examiner, Group 1700

J.Chu
December 11, 2002